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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFRY JOVAN PHILYAW and
DAVID KENT MATHEWS

Appeal 2008-002956
Application 09/382,374
Technology Center 3600

Decided: February 1, 2010

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jeffry Jovan Philyaw, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-7 and 9-14. Claim 8 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART and add a new ground of rejection under 35 U.S.C. § 112, second paragraph.[1]

THE INVENTION

The invention "is related to a method of computer control and, more particularly, to a system and method for remotely controlling a computer in response to a broadcast signal." Specification: p. 2.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A system for launching an advertisement on a computer, comprising:
>
> a computer having an audio input interface and a display;
>
> an audio output acoustically coupled from a broadcast receiver of a broadcast source to said audio input interface for providing an audio signal having encoded therein advertisement information that is comprised

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[1] Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Aug. 3, 2007) and Reply Brief ("Reply Br.," filed Dec. 17, 2007), and the Examiner's Answer ("Answer," mailed Oct. 18, 2007).

of both advertising content and control information;

a computer program operable on said computer and responsive to said audio signal output from said receiver of said broadcast source to allow said computer program to be controlled by the received control information for output of the advertising content, said program comprising:

a program for accessing the advertising information coupled from said receiver of said broadcast source;

a decoder for decoding the received advertising information encoded in said audio signal to provide decoded advertising content and decoded control information, and

means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

McKiel, Jr.	US 5,133,011	Jul. 21, 1992
Tognazzini	US 5,708,478	Jan. 13, 1998
Harvey	US 5,887,243	Mar. 23, 1999
Picco	US 6,029,045	Feb. 22, 2000

The following rejections are before us for review:

1. Claims 1, 5, 7, 9-11, and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tognazzini, Picco, and Harvey.
2. Claims 2-4, 6, 12, and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tognazzini, Picco, Harvey, and McKiel, Jr.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 5, 7, 9-11, and 13 under 35 U.S.C. §103(a) as being unpatentable over Tognazzini, Picco, and Harvey.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 2, 3, 4, 6, 12, and 14 under 35 U.S.C. §103(a) as being unpatentable over Tognazzini, Picco, Harvey, and McKiel, Jr..

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Ans. 3-22.

PRINCIPLES OF LAW

Obviousness

> Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

> would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham,* 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1, 5, 7, 9-11, and 13 under §103(a) as being unpatentable over Tognazzini, Picco, and Harvey.

The Appellants argued claim 1 (App. Br. 19-38) and relied on the arguments made with respect to claim 1 in arguing claims 5 and 7. (App. Br. 38).

The Appellant argued claim 10 (App. Br. 38-39) and relied on the arguments made with respect to claim 10 in arguing claims 11 and 13 (App. Br. 39). Accordingly, we will treat claims 10, 11, and 13, as a second group, selecting claim 10 as representative of this second

group and the remaining claims 11 and 13, stand or fall with claim 10. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 9 depends on cancelled claim 8 and therefore falls in no group.

Claims 1, 5, and 7

We will reverse the rejection as to claims 1, 5, and 7. As further explained below, we will enter a new ground of rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, because they are indefinite. Therefore, their rejection over prior art must fall, pro forma, as being necessarily based on speculative assumptions as to the scope of this claim. *See In re Steele,* 305 F.2d 859, 862-63 (CCPA 1962). Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

Claims 10, 11, and 13

Claim 10 reads as follows:

> 10. A method for launching an advertisement on a computer comprising the steps of:
>
> providing a computer having an audio input interface responsive to an audio signal output from a broadcast receiver of a broadcast source and a display coupled to the computer;
>
> receiving the audio signal output having advertising information encoded therein at the audio input interface that is comprised of

> both advertising content and control information and decoding the advertising information for processing by the computer to provide decoded advertising content and decoded control information;
>
> initiating execution of a computer program on the computer responsive to the audio signal having the encoded control and advertising information by the steps of:
>
> interpreting the decoded received advertising information received during the receiving step to determine if the decoded advertising content is to be displayed based upon the decoded control information; and
>
> launching a display of the decoded advertising content upon the display wherein the decoded control information is determined to indicate such substantially at the time of reception of the advertising information.

The Examiner's position is that Tognazzini discloses all the claim limitations except "control information that is sent to the user computer for controlling whether to display the advertising information" (Answer 4). To meet that limitation, the Examiner cites Picco. The Examiner states that "Picco discloses sending the advertising information with the control information in the broadcast wherein the control information controls whether to display that advertising information" and cites the passage at col. 8, ll. 21-40 (Answer 4). The Examiner also states that Picco discloses "that the local content can be advertisements," "utilizing a variety of communication methods," and " a computer network can be utilized,

the Internet and computer," citing passages at col. 6, ll. 34-41, col. 1, ll. 5-12, and col. 14, ll. 57-67 of Picco, respectively. The Examiner found that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Picco's advertiser control of advertising information sent with advertising information to Tognazzini's advertiser provided information. One would have been motivated to do this in order to allow the advertiser better control of advertisement display in order to more effectively reach a user." Answer 5-6.

The Appellants dispute, in part, that the cited references disclose or would lead one of ordinary skill to provide the claim 10 step "launching a display of the decoded advertising content upon the display wherein the decoded control information is determined to indicate such substantially at the time of reception of the advertisement information." App. Br. 36-37. According to the Appellants, "all three references provided by the Examiner teach away from an advertising information comprising advertising content and control content wherein the control content controls the display of the advertising content [at] substantially the same time that the advertising information was received." Reply Br. 20.

The Examiner responds that "Picco discloses content and advertising that are live or real-time broadcast. Additionally, Harvey discloses that the control information is broadcast with a live/real-time broadcast content and that the control information can include control information relevant to the broadcast content" (Answer 19), citing col. 179, ll. 15-39 of Harvey. The Examiner had previously also cited the

disclosure at col. 284, ll. 30-55 of Harvey in support of "real time control of a computer based on broadcast transmissions including control of content or display information." Answer 6. According to the Examiner,

> the combination of the prior art renders obvious advertising and control information which are sent in conjunction with each other such that the advertising information can be displayed at substantially the same time that the control information was received or displaying the broadcast information at substantially the same time as the control information was received. Hence, the combination of the prior art renders obvious advertisement information comprising both advertising content and control content such that the advertising content can be displayed at substantially the same time that the advertisement information as received.

Answer 20-21.

We have reviewed the record and find that the Appellants have the better argument.

The method of claim 10 requires

> initiating execution of a computer program on the computer responsive to the audio signal having the encoded control and advertising information by the steps of: interpreting the decoded received advertising information received during the receiving step to determine if the decoded advertising content is to be displayed based upon the decoded control information; and launching a display of the decoded advertising content upon the display wherein the decoded control information is determined to indicate such substantially at the time of reception of the advertising information.

Accordingly, the method requires (1) a program and (2) and audio signal having encoded control and advertising information. The

program's execution is initiated by the audio signal via two steps: (a) based on decoded control information, interpreting received and decoded advertising information to determine if the decoded advertising content is to be displayed and (b) if the decoded control information determines if the decoded advertising content is to be displayed, then launching a display of the decoded advertising content substantially at the time of reception of the advertising information.

We find that one of ordinary skill in the art would not arrive at a method to execute a program initiated by an audio signal having encoded control and advertising information if the decoded control information determines the decoded advertising content is to be displayed and then launching a display of the decoded advertising content substantially at the time of reception of the advertising information as claimed. As the Examiner has indicated, Tognazzini does not disclose launching a display of the decoded advertising content substantially at the time of reception of the advertising information based on a determination by decoded control information as claimed. Picco discloses that live feeds and local content may be transmitted to a set top box but "the local content may not be transmitted in real-time in that the local content is not immediately viewed by the user of the set-top box since the set-top box inserts the local content into the satellite signals as needed." Col. 8, ll. 32-36. Accordingly, the sequential manner by which Picco effects a display of advertising, as local content, *teaches away* from launching a display of the decoded advertising content substantially at the time of reception of the advertising information based on a determination by

decoded control information as claimed. Picco would not lead one of ordinary skill to include a step of launching a display of the decoded advertising content substantially at the time of reception of the advertising information based on a determination by decoded control information in the Tognazzini process. Harvey does not appear to disclose a step of launching a display of the decoded advertising content substantially at the time of reception of the advertising information based on a determination by decoded control information. Col. 179, ll. 15-39 of Harvey, which the Examiner cites, describes transmitting programming and SPAM information to intermediate transmission station which can be encrypted or decrypted. Col. 284, ll. 30-55, which the Examiner cites, describes SPAM information embedded in a video signal which causes a decoder apparatus to commence receiving the SPAM information. "SPAM" refers to signals that "control and coordinate a wide variety of subscriber stations" (col. 22, ll. 3-4) and "includes data, computer program instructions, and commands" (col. 22, ll. 35-36). At best, Harvey might suggest a display of informational content based on the determination of control information. But one would not arrive at a step of launching a display of the decoded advertising content substantially at the time of reception of the advertising information based on a determination by decoded control information given these disclosures. Accordingly, Harvey would not lead one of ordinary skill to include a step of launching a display of the decoded advertising content substantially at the time of reception of the advertising

information based on a determination by decoded control information in the Tognazzini process.

We therefore find a prima facie case of obviousness for the claimed subject matter over the cited prior art combination has not been established.

The rejection of claims 2- 4, 6, 12, and 14 under §103(a) as being unpatentable over Tognazzini, Picco, Harvey, and McKiel, Jr.

The Appellant argued claims 2, 3, 4, 6, 12, and 14 as a group. App. Br. 39-41. We select claim 2 as the representative claim for this group, and the remaining claims 3, 4, 6, 12, and 14 stand or fall with claim 2. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

We will reverse the rejection as to claims 2-4 and 6. As further explained below, we will enter a new ground of rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, because they are indefinite. Therefore, their rejection over prior art must fall, pro forma, as being necessarily based on speculative assumptions as to the scope of this claim. *See In re Steele,* 305 F.2d 859, 862-63 (CCPA 1962). Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

Turning now to claims 12 and 14, we will reverse the rejection for the reasons indicated *supra* in reversing the rejection of the independent claim 10 on which these claims depend.

NEW GROUNDS

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1, 5, and 7 under 35 U.S.C. § 112, second paragraph as being indefinite

Principles of Law

Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, paragraph 6, by "look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." *In re Donaldson Co.,* 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

When no structure is described in the Specification to support a means-plus-function limitation in a claim, the disclosure is inadequate to explain to one of ordinary skill in the art what is meant by the claim language. In such a situation, a means-plus-function claim would not be amenable to construction and thus would fail to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

> "[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.,* 16 F.3d 1189, 1195 (Fed.Cir.1994) (en banc). …. This duty to

> link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶ 6. *See O.I. Corp. v. Tekmar Co.,* 115 F.3d 1576, 1583 (Fed. Cir. 1997). "Fulfillment of the § 112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure." *Atmel,* 198 F.3d at 1382. While corresponding structure need not include all things necessary to enable the claimed invention to work, it must include all structure that actually performs the recited function. *See Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.,* 296 F.3d 1106, 1119 (Fed.Cir.2002).

Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc., 412 F.3d 1291, 1298 (Fed. Cir. 2005).

When the means-plus-function limitation in a claim is a *computer-enabled* means-plus-function limitation, one must set forth in the specification sufficient description of an *algorithm* associated with the function recited in the claim in order to avoid a finding that an applicant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

> It is certainly true that the sufficiency of the disclosure of algorithmic structure must be judged in light of what one of ordinary skill in the art would understand the disclosure to impart. *See, e.g., Intel Corp. v. VIA Techs.,* 319 F.3d 1357, 1367 (Fed. Cir. 2003) (knowledge of a person of ordinary skill in the art can be used to make clear how to implement a disclosed algorithm); *Atmel Corp.,* 198 F.3d at 1379 ("[T]he 'one skilled in the art' analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation."). That principle, however, has no application here, because in this case there was no algorithm at all disclosed in the specification. The question thus is not whether the algorithm that was

> disclosed was described with sufficient specificity, but whether an algorithm was disclosed at all.

Aristocrat Techs. Australia Party. Ltd. vs. Int'l Game Tech., 521 F.3d 1328, 1337 (Fed. Cir. 2008).

When there is insufficient description of an algorithm in the Specification to support a computer-enabled means-plus-function limitation in a claim, the disclosure will be considered inadequate to explain to one of ordinary skill in the art what is meant by the claim language.

> For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, "the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." WMS Gaming, Inc. v. Int'l Game Tech., 184 F.3d 1339, 1349 (Fed.Cir.1999). Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6. This court permits a patentee to express that algorithm in any understandable terms including as a mathematical formula, in prose, see In re Freeman, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure. [new ¶] The district court correctly determined that the structure recited in the '505 specification does not even meet the minimal disclosure necessary to make the claims definite. Simply reciting "software" without providing some detail about the means to accomplish the function is not enough. See Aristocrat Techs. Austl. Pty v. Int'l Game Tech., 521 F.3d 1328, ---- (Fed.Cir.2008) ("For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers

> can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6."). This court does not impose a lofty standard in its indefiniteness cases. See, e.g., Med. Instrumentation & Diagnostics Corp. v. Elekta AB, 344 F.3d 1205, 1214 (Fed.Cir.2003). But in this case, the claims are already quite vague. Without any corresponding structure, one of skill simply cannot perceive the bounds of the invention.

Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340-41 (Fed. Cir. 2008).

When a specification discloses *no* algorithm corresponding to a computer-enabled means-plus-function limitation in a claim, an applicant has necessarily failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. *See also Aristocrat*, 521 F.3d 1328, 1333 (*quoting Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005) ("'[t]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification.' *Harris* 417 F.3d at 1249."); *Net MoneyIN, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1367 (Fed. Cir. 2008) ("[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function."). *See also Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371 (Fed. Cir. 2009) (finding Blackboard's means-plus-function claims indefinite because the patent describes an undefined component, *i.e.*, a black box, that

performs the recited function but does not disclose how the component performs the function). *See further Ex parte Catlin*, 90 USPQ2d 1603, 1605 (BPAI 2009) (precedential) (during prosecution, computer-enabled means-plus-function claims will be held unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite if a Specification fails to disclose any algorithm corresponding to the recited function in the claims).

Analysis

We reject claims 1, 5, and 7 under 35 U.S.C. § 112, second paragraph as being indefinite. We take claim 1 as representative.

The limitation "means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information" includes the term "means." A claim limitation that includes the term "means" is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech.*, Inc., 174 F.3d 1294, 1302 (Fed. Cir. 1999) ("presumed an applicant advisedly used the word 'means' to invoke the statutory mandates for means-plus-function clauses.").

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

> The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.,* 250 F.3d 1369, 1376 (Fed.Cir.2001). "The court must

> construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations." *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.,* 296 F.3d 1106, 1113 (Fed.Cir.2002). Thus, according to the language of claim 11, the function of the "horizontal drive means" is "rotating said lamp unit in a horizontal direction." Ordinary principles of claim construction govern interpretation of this claim language, see id., and, for all the reasons discussed in the preceding two sections, we construe this function according to its ordinary meaning as not requiring rotation through 360°.
>
> The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. "Under this second step, 'structure disclosed in the specification is "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.' " *Med. Instrumentation & Diagnostics Corp. v. Elekta AB,* 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.,* 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

Step 1- The first step in construing a means-plus-function claim limitation is to define the particular function in the means-plus-function limitation.

The particular function of the means-plus-function claim limitation at issue is "launching said decoded advertising content on said display of said computer under the control of said decoded

control information substantially at the time of reception of the advertisement information".

Further, given the claim as a whole being directed to a system involving a computer, one of ordinary skill in the art would construe the claim limitation "means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information" to refer to a *computer-enabled* means-plus-function limitation.

Step 2 The next step in construing a means-plus-function claim limitation is to look to the Specification and identify the corresponding structure for that function. Given that the claim limitation "means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information" is a *computer-enabled* means-plus-function limitation, this requires looking to the Specification and identifying the algorithm corresponding to the function "launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information". *See also Blackboard, Inc.*, 574 F.3d at 1375, *Net MoneyIN, Inc.*,545 F.3d at 1367, *Finisar Corp.*, 523 F.3d at 1340-41, *Aristocrat,* 521 F.3d at 1337, and *Ex parte Catlin*, 90 USPQ2d at 1605, *supra.*

In that regard, we note that in the Summary of Claimed Subject Matter (App. Br. 6-7), the Appellants have made no attempt to show

where in the Specification, by page and line number, where there is disclosed structure, material, or acts corresponding to the claimed function as required by 37 C.F.R. § 41.37(c)(1)(v) (2007).

We have noticed that in the Summary of Claimed Subject Matter (App. Br. 6, fn. 22) the Appellants did cite to specific disclosure in the Specification for written descriptive support for the claim 10 step "launching a display of the decoded advertising content upon the display wherein the decoded control information is determined to indicate such substantially at the time of reception of the advertisement information," which parallels the function at issue here. The specific disclosure is said to be at p. 13, ll. 23 - p. 14, l. 10; p. 15, ll. 7-12; and p. 20, l. 24 - p. 21, l. 20. We have reviewed these disclosures but have not been able to discern the algorithm corresponding to the function "launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information."

The disclosure at p. 13, ll. 23 - p. 14, l. 10 of the Specification explains that "information will be relayed to a proprietary location and the instructions sent back to the PC 112 [*see* Fig. 1] as to the location of the advertiser associated with the code, and the PC 112 will then effect a communication link to the location such that the user can view on the display 118 information that the advertiser, by the fact of putting the tone onto the broadcast onto the broadcast channel, desires the viewer to view." P. 14, ll. 5-10. :

The disclosure at p. 15, ll. 7-12 of the Specification is reproduced below:

> This advertising content, under the control of a computer program running on PC 112, may then be displayed to the user on display 118. Thus, the program being broadcast, provided by TV broadcast source 104 and which contains the advertiser data input 100, may be used to remotely control the PC 112 from the broadcast source by controlling the receipt and display thereby of the advertising message encoded in the audio output signal.

The disclosure at p. 20, l. 24 - p. 21, l. 20 of the Specification describes a method of detecting and obtaining product information as shown in Fig. 5. The method begins "[i]n decision block 500, [where] a proprietary application running resident on a source computer PC 302 ... monitors the audio input for a special trigger signal." P. 20, l. 25 - p. 21, l. 1. According to this disclosure, "[t]he user may obtain the benefits of this architecture by simply downloading the proprietary software over the network." P. 21, ll. 18-19.

We see nothing in these disclosures which describe an algorithm corresponding to the function "launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information." A review of the remaining disclosure did not reveal an algorithm which launches decoded advertising content on a computer display (a) under the control of the decoded control information and (b) substantially at the time of reception of the advertisement information. Various passages in the Specification appear to suggest that this is accomplished via

"proprietary software" (see e.g., p. 16, l. 26), which is not described in any algorithmic detail.

In our view the Specification repeats, in different words, the function at issue. There is no disclosure that explains the structure of the algorithm itself that would cause the recited function to be performed. Also, there is no evidence on the record that one of ordinary skill in the art at the time of the invention would have understood what this algorithm would be, especially given the suggestion in the Specification that the necessary software is proprietary.

Given all this, we find that the Specification does not adequately describe an algorithm corresponding to the function "launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information" such that one of ordinary skill in the art could determine the scope of claim 1.

For the foregoing reasons, we find that the Specification does not adequately describe an algorithm corresponding to the function "launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information." The Specification fails to disclose an algorithm corresponding to the recited function at issue in claim 1 such that one of ordinary skill in the art could determine the scope of claim 1.

Accordingly, we reject claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The analysis above applies equally as well to dependent claims 2-7. Claims 2-7 depend from claim 1 and therefore include the same deficiency. Thus, claims 2-7 are also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claim 9 under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 9 is necessarily indefinite because it is pending and yet depends on a cancelled claim.

CONCLUSIONS OF LAW

We reverse the rejection of claims 1, 5, 7, 9-11, and 13 under 35 U.S.C. §103(a) as being unpatentable over Tognazzini, Picco, and Harvey and of claims 2, 3, 4, 6, 12, and 14 under 35 U.S.C. §103(a) as being unpatentable over Tognazzini, Picco, Harvey, and McKiel, Jr..

We enter a new ground of rejection of claims 1-7 and 9 under 35 U.S.C. § 112, second paragraph.

DECISION

The decision of the Examiner to reject claims 1-7 and 9-14 is affirmed-in-part and we enter a new ground of rejection of claim 9 under 35 U.S.C. § 112, second paragraph.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> • (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> • (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

mev

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